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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,739	03/07/2002	Klaus Knoerr	ADI-082	7325

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT	PAPER NUMBER
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1773

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DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

19-2

Office Action Summary

Application No.

10/092,739

Applicant(s)

KNOERR, KLAUS

Examiner

D. S. Nakarani

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1 & 4-6</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9 are, drawn to a process, classified in class 156, subclass 307.1⁺.
 - II. Claims 10-20 are, drawn to a sole and an article of footwear, classified in class 36, subclass 30R⁺.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as providing either support element or a sole element positioning either the support element or the sole element in a mold and injecting a composition forming either a sole element or support element. Followed by heating under pressure to cure and cooling and removing formed article from the mold.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Mr. John V. Forcier on June 17, 2003 a provisional election was made without traverse to prosecute the invention of group II, claims 10-20.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ritter (U.S. Patent 6,061,929).

Ritter discloses a footwear sole comprising forefoot (16) and heel (18) portions of soft low density and midfoot region (14) portion of denser and harder. The portions (16), (18) and (14) are made of cross-linked EVA (col. 3, lines 10-25 and Fig. 1, col. 3, line 62 to col. 4, line 22). The portion (14) viewed as a support element and portions (16) and (18) are viewed as sole element. Further Fig. 5 show top element 72 made of EVA and midsole 70 also made of EVA (col. 6, lines 13-31).

11. Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter (U.S. Patent 6,061,929) in view of Tanuma et al (U.S. Patent 4,511,627).

Ritter, which has been discussed above. Ritter also disclose that the sole can be used for shoes. Ritter also discloses that sole can be one of plural soles comprising an outsole, an innersole and midsole (sol. 5, lines 7-20). The bonding upper portion of shoes or sandals to the sole is a conventional and known in the art. Ritter fail to disclose content if a vinyl acetate in the EVA and other necessary cross-linking additives.

Tanuma et al disclose a cross-linkable composition comprising EVA containing 15 to 50 wt% vinyl acetate (col. 2, lines 3-5), peroxide (col. 5, lines 20-46) and cross-linking agent such as acrylates and isocyanates (col. 3, lines 18-46 and Table 3).

Therefore it would have been obvious to a person of ordinary skill in the art at the time of this invention made to utilize disclosure of Tanuma et al in the invention of Ritter to cross-link EVA using peroxide and acrylates and/or isocyanate disclosed by Tanuma et al.

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No claims are allowed.

12. Receipt of Information Disclosure Statements files March 7, 2002, April 3, 2002, July 22, 2002 and September 16, 2002 is acknowledged and all references have been made of record.


Non-English reference 2488829 has been considered to the extent of provided an English abstract.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is 703-308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

D. S. Nakarani/mn
July 3, 2003


D. S. NAKARANI
PRIMARY EXAMINER